

Attorney Docket No 6594.200-US
Sauerberg et al.
Serial No. 10/734,368 Filed December 12, 2003
Via Facsimile No.: 571-273-8300

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RESPONSE

The examiner states in the Office Action Summary that claims numbered 1-73 are pending in the application; claims numbered 1-4, 9-11, 16-22, 24, 26-28, 32-34, 38-52, 54 and 63-69 are rejected; claims numbered 58, 59 and 61 are objected to. Claims withdrawn from consideration are 5-8, 12-15, 23, 25, 29-31, 35-37, 53, 55-57, 60, 62, and 70-73. The examiner also states claims numbered 1-73 are subject to restriction and/or election requirement.

Claims numbered 1, 48, 54, 58, 59, 61, 66 and 69 are amended herein. Claims numbered 49-52 and 67-68 are cancelled herein.

- (1) The examiner states the title of the invention is not descriptive, and a new title is required that is clearly indicative of the invention to which the claims are directed.

Applicant has herein amended the title of the pending application.

- (2) The examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the specification does not provide support for the limitation C₁₋₃-alkoxy, as disclosed in claims 40 and 45.

Applicant respectfully directs the examiner's attention the definition provided on page 5, lines 24-29 of the specification as filed, and to Example 41, located on page 83, line 29 through page 84, line 1 of the specification as filed, which Applicant believes clearly provides support for C₁₋₃-alkoxy.

Applicant respectfully requests reconsideration and withdrawal of the objection to the specification.

- (3) Claim number 66 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim number 66 recites a broad range of limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim).

Applicant has amended claim number 66 to refer to the recited ranges in the alternative.

Applicant respectfully requests reconsideration and withdrawal of the rejection to

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claim number 66 under 35 U.S.C. § 112, second paragraph.

(4) The examiner has rejected claims numbered 1-4, 9-11, 16, 17, 19, 20, 22, 24, 26-27, 32-33, 38-52 and 63-69 under 35 U.S.C. § 102(b) as being anticipated by sauerberg et al. (WO 01/79150).

Applicant has amended claims numbered 1, 48, 58-59, and 61 to remove overlapping subject matter.

Applicant respectfully requests reconsideration and withdrawal of the rejection to claims numbered 1-4, 9-11, 16, 17, 19, 20, 22, 24, 26-27, 32-33, 38-52 and 63-69 under 35 U.S.C. § 102(b).

(5) The examiner has rejected claims numbered 1-4, 9-11, 16, 17, 19, 20, 22, 24, 26-27, 32-33, 38-52, 54, and 63-69 under 35 U.S.C. § 102(e) as being anticipated by Sauerberg et al. (US 2003/0109579).

Applicant respectfully disagrees with the examiner's rejection. Applicant respectfully directs the examiner's attention to US 2003/0109579, paragraphs [0066]-[0071] and corresponding portions of claim number 1 in the same publication. The options for substituents T and U in the present application are different from those disclosed and claimed in the US 2003/0109579 publication, therefore a rejection under 35 U.S.C. § 102(b) is not proper.

Applicant respectfully requests reconsideration and withdrawal of the rejection to claims numbered 1-4, 9-11, 16, 17, 19, 20, 22, 24, 26-27, 32-33, 38-52, 54, and 63-69 under 35 U.S.C. § 102(e).

(6) The examiner has rejected claims numbered 18, 21, 28 and 34 under 35 U.S.C. § 103(a) as unpatentable over Sauerberg et al. (WO 01/79150).

Applicant has amended claim number 1, thereby obviating the examiner's rejection.

Applicant respectfully requests reconsideration and withdrawal of the rejection to claims numbered 18, 21, 28 and 34 under 35 U.S.C. § 103(a).

(7) The examiner has rejected claims numbered 18, 21, 28 and 34 under 35 U.S.C. § 103(a) as unpatentable over Sauerberg et al. (US 2003/0109579).

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In reply, Applicants state: "The present application and U.S. Patent Application Serial Number 10/272,613 (US 2003/0109579, now U.S. Patent 7,220,877) were, at the time the invention of the present application was made, owned by Novo Nordisk".

Evidence of common ownership of the present application and of U.S. Patent Application Serial Number 10/272,613 (US 2003/0109579, now U.S. Pat 7,220,877) is provided by the assignments recorded at reel/frame numbers 015616/0143 and 013568/0509 respectively. Accordingly, by virtue of this evidence and the above statement, Applicants submit US 2003/0109579 is disqualified as prior art for purposes of 35 U.S.C. § 103.

Applicant respectfully requests reconsideration and withdrawal of the rejection to claims numbered 18, 21, 28 and 34 under 35 U.S.C. § 103(a).

(8) The examiner states claims numbered 58, 59 and 61 are objected to as being dependent upon a rejected base claim.

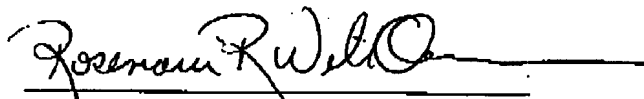
Applicant believes in light of amendments and arguments presented the objection to claims numbered 58, 59 and 61 are moot.

Applicant respectfully requests reconsideration and withdrawal of the objection to claims numbered 58, 59 and 61.

The examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Rosemarie R. Wilk-Orescan
Registration Number 45,220
Novo Nordisk Inc.
100 College Road West
Princeton, NJ 08540
(609) 987-5969

CUSTOMER NUMBER 23650